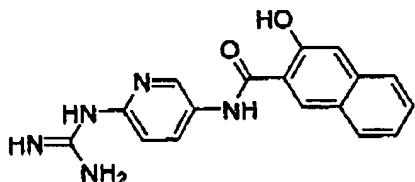


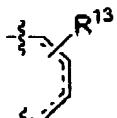
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consideration. Restriction Requirement I was maintained in an Office Action dated December 5, 2001, the Applicants requested reconsideration of the objection to Group I as containing non-elected subject matter in their June 24, 2002 Response. All other substantive issues were resolved and Applicants thus believed the Application was put in condition for allowance. In a final Office Action dated November 20, 2002, the Examiner again maintained the objection to Claims 1-8 and 10-17 as containing non-elected subject matter. The Applicants requested that the Examiner reconsider and also filed a Petition from Requirement for Restriction under 37 C.F.R. § 1.144 (2003). The Petition was granted (hereinafter "Granted Petition") with direction to the Examiner to examine Claim 1 in its full breadth.

On remand, the Examiner made a second Requirement for Restriction mailed on August 4, 2003 (Restriction Requirement II). A Response was made on August 26, 2003 in which the Applicants elected the species found on page 66, line 8, of the Specification, namely 3-hydroxy-naphthalene-2-carboxylic acid (6-guanidino-pyridin-3-yl)-amide,



where, in Formula I, R¹, R⁴, R⁸, R⁹, R²⁰, and R⁵³ are each hydrogen, R⁵¹ and R⁵² together form =O, R⁵ is hydroxy, X, X², X³, and X⁴ are each carbon, X¹ is nitrogen, and R² and R³ together



form

and R¹³ is hydrogen. The Applicants also traversed the Restriction to the extent that nonelected subject matter would be withdrawn from consideration permanently and requested reconsideration. A non-final Office Action was sent on November 19, 2003 in which the Examiner maintained the Restriction Requirement II and did not extend the search, citing 35 U.S.C. 121 and 37 C.F.R. 1.142(b) as authority for restricting the Applicants' Invention.

Arguments

Restriction Requirement

The proper restriction practice for Markush claims is described in M.P.E.P. § 803.02 with which the Examiner fails to comply. In the Granted Petition, the Director recognized this and

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stated: "It is clear from the prosecution of the application that the examiner has failed to follow the procedures outlined in M.P.E.P. § 803.02 following an election of species." The Director gave further direction that "[c]laim 1 will be examined in its full breadth in accordance with M.P.E.P. 803.02" (emphasis added). The Applicants also point out that the Director, himself, has found that an extension of the examination and search would not be burdensome (see p. 3 of Granted Petition). The Applicants respectfully request that the Examiner comply with the instructions given by the Director and examine Claim 1 in its full breadth.

Objections

Claims 1-8 and 10-17 are objected to as containing nonelected subject matter. The Applicant maintains that the objection is improper. Therefore, the objection to Claims 1-8 and 10-17 is premature and should be kept in abeyance until the claims have been examined in their full breadth and are allowed.

Summary

In conclusion, the Patent and Trademark Office Board of Patent Appeals and its reviewing court have clearly and unequivocally held that the Patent Office may not require the narrowing of a generic claim pursuant to a restriction requirement. In response to the Applicants' petition to review Restriction Requirement I, the matter was remanded to the Examiner with instructions to examine claim 1 "in its full breadth in accordance with M.P.E.P. 803.2". Accordingly, the Applicants respectfully request that the remainder of their generically claimed invention be examined on the merits and that, in the absence a statutory or judicially created basis for forming a rejection, Claims 1-8 and 10-17 be allowed.

Respectfully submitted,

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February 19, 2004

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